



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/213,834	12/17/1998	YURI (IOURI) ROMANTCHIKOV	99999/400400	6351

26646 7590 03/13/2003

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/13/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/213,834

Applicant(s)

ROMANTCHIKOV, YURI (IOURI)

Examiner

Marjorie A. Moran

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/28/01.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30,33-38 and 40-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-30,33-38 and 40-68 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant is advised that the examiner for this application has changed. The examiner apologizes for the lengthy interval between the filing of the last response, on February 28, 2001, and this office action, and thanks applicant for bringing this to the current examiner's attention. The amendment filed 2/28/01 has been entered. In order to facilitate further search and examination of the claims, the following restriction requirement is applied to the pending claims. All arguments set forth in the response of 2/28/01 will be held in abeyance until an election is made.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-30, drawn to methods of inserting a nucleic acid fragment into a circular vector, classified in class 435, subclass 91.4.
- II. Claims 33-36 and 65, drawn to a mixture of nucleic acid vectors, classified in class 536, subclass 23.1.
- III. Claims 37-38, 40-41, 54-55, 60-61, and 66, drawn to nucleic acid inserts, kits, vectors and libraries wherein the nucleic acids comprise cohesive ends which can not be covalently joined by ligase, classified in class 536, subclass 23.1.
- IV. Claims 42-47, 51-52, and 57-58, drawn to nucleic acid inserts, kits, vectors and libraries, wherein the nucleic acids comprise an end linked to a topoisomerase, classified in class 435, subclass 233.

- V. Claims 48-50, drawn to a nucleic acid insert and kit comprising a cos site, classified in class 536, subclass 23.1.
- VI. Claims 53, 56, 59, and 62, drawn to a nucleic acid insert, construct, and libraries, wherein the insert does NOT comprise a bacteriophage or cos site, classified in class 536, subclass 23.1.
- VII. Claims 63-64, drawn to libraries of nucleic acid vectors without an insert size bias, classified in class 536, subclass 23.1.
- VIII. Claims 67-68, drawn to methods for insertion of a nucleic acid into a circular vector which recite no method steps, classified in class 435, subclass 91.4.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and VIII are related to Inventions II-VII as processes of making and products made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the methods of Groups I can be used to make any of the various products of Groups II-VII. In addition, the method of Group VII can be used to make any of the products of Groups II-VII.

Inventions I and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In

the instant case the different inventions are apparently directed to different methods. As the methods of Group VIII do not recite any definite method steps, but are independent claims, they are interpreted to be different from the methods of Group I. Applicant is advised that addition of method steps may result in further restriction between claims 67 and 68.

Groups II-VII are each separate and distinct. Although the claims of each Group are directed to nucleic acid inserts in various forms, each Group recites different structural limitations for the insert/vector, therefore each Group is directed to a distinct structure/compound. As each Group is directed to a different product which is distinct from that of any other Group, each of Groups II-VII is separate and distinct.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VIII, the search required for Group II is not required for Groups I and III-VIII, the search required for Group III is not required for Groups I-II and IV-VIII, the search required for Group IV is not required for Groups I-III and V-VIII, the search required for Group V is not required for Groups I-IV and VI-VIII, the search required for Group VI is not required for Groups I-V and VII-VIII, the search required for Group VII is not required for Groups I-VI and VIII, and the search required for Group VIII is not required for Groups II-VII, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Claims 1-30, 33-38, 40-68 are pending and are subjected to restriction. Applicant is encouraged to contact the examiner at the number below if there are questions concerning this restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Wednesday, 7:30 am to 4 pm, Thursday, 7:30 am to 6 pm, and Friday, 7:30 am to 1:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.

MARJORIE MORAN
PATENT EXAMINER

Marjorie A. Moran